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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,930

Applicant(s)

WAITE ET AL.

Examiner

Etienne P. LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).¹
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/2003</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Status

Claims 1-43 are pending. Claims 1-43 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes the following instances of the following parameters:

attributes (13)

items (13)

possibilities (3)

values (8)

natural items (2)

The claim is indefinite because it is unclear how many instances of the above parameters Applicant is claiming. Furthermore, it is unclear whether “possibilities” relate to attributes and/or values. For purposes of this first action on the merits, examiner will assume that the thirteen instances of attribute refer to one attribute, the thirteen instances of item refer to one item, the three instances of possibility refer to one possibility, the eight instances of value refer to one value and the two instances of natural item refer to one natural item.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is directed to non-statutory subject matter.

The claimed apparatus must have a practical application in the real world. The claimed apparatus must be useful, concrete and tangible to ensure that it has a real world practical application.

Claim 1 recites “whereby the elimination means, in the step-by-step elimination search, assures against a null result of the search.” This claimed final result step is not useful, concrete or tangible. It is not useful to obtain a non-null result that comprises a plurality of search results which have no claimed relevance to the search criteria. Furthermore, the claimed steps are not repeatable (i.e., concrete) such that a first user, or a second user can obtain consistent search results because Applicant claims thirteen attributes, thirteen items, three possibilities and eight values. The final result is not tangible (having real world value) because it is unclear what the search result includes, i.e., one or more of attributes, items, possibilities or values such that a user is able to identify a natural item in the field as claimed in the preamble.

Furthermore, Claim 1 recites “whereby the elimination means, in the step-by-step elimination search, assures against a null result of the search.” This final result is not useful because it is possible that the natural item the bird watcher is currently observing in the field is not included in the database and because the user **must** (emphasis added) obtain a result per the claim 1, the result inherently is erroneous.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Pub No US 2002/0152225 issued to Kevan et al (hereafter Kevan).

Claim 1:

Kevan discloses:

a housing for the portable computer device, the housing containing a programmed microprocessor, data storage, a display screen and a user input [cradle 14, Fig 1]

means in the microprocessor and data storage for displaying to the user a series of selectable attributes which vary among items in the collection of natural items, each attribute having one or more data types in which a plurality of values for such attributes are stored in the data storage [Fig 1]

the values for the various attributes being in a plurality of the following data types stored in the database for presentation to the user in a search conducted by the user:

- (a) descriptive text [paragraph 50]
- (b) number values [paragraph 65, number of regions where bird may be found]
- (c) color images of items in the collection of items [color or grey-scale images, paragraph 50],
- (d) sounds produced by items, in the case of a group of animals as the collection

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of items [audio files of songs or calls, paragraph 50],

(e) moving pictures of items, in the case of animals as the items of the collection [video file, paragraph 50],

(f) color samples for matching to a feature of an observed item of a collection of items [color or grey-scale images, paragraph 50]

(g) silhouettes representative of groups of items within a collection of items [photograph of the bird, paragraph 91], and

search means associated with the microprocessor for enabling and prompting the user, on the display screen, to perform a step-by-step elimination search to identify an item observed in the field by selecting an attribute, reviewing various values presented by the portable computer device as possible values under the subject attribute for the item observed in the field, then selecting a value for the attribute, then selecting another attribute, reviewing values presented as possibilities for that attribute and selecting a value, and continuing the stepwise elimination search to further reduce the number of possibilities in the items of the collection, the search means progressively eliminating non-matches from a list of possibilities [paragraph 72],

and including elimination means associated with the microprocessor for eliminating further attributes which become irrelevant or redundant after selection by a user of a particular value for an attribute, and further including means associated with the microprocessor for eliminating certain values under particular attributes which values become irrelevant or redundant as choices due to prior selection of particular values under one or more previously selected attributes [abstract, paragraphs 24, 72, 73],

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whereby the elimination means, in the step-by-step elimination search, assures against a null result of the search [Fig 4A, steps 56 and 58, browse list of birds is presented, paragraph 61]

Claim 2:

The field-useable guide of claim 1, wherein the portable computer device is internet enabled, and at least some of the values for at least some of the attributes including web links to further information or images, as a data type in which such values are stored [paragraph 51].

Claim 3:

The field-useable guide of claim 1, wherein the portable computer device is a PDA [paragraph 14].

Claim 4:

The field-useable guide of claim 1, wherein the portable computer device is a laptop computer [paragraph 14].

Claim 5:

The field-useable guide of claim 1, wherein the portable computer device is a mobile phone with display [paragraph 14].

Claim 6:

The field-useable guide of claim 1, wherein the collection of natural items comprises a class of living things, and wherein the attributes include geographic location where observed [paragraph 65].

Claim 7:

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The field-useable guide of claim 6, wherein the class of living things comprises birds, and wherein the attributes include silhouette, wingspan, color of a designated part of the bird, and eye color [paragraphs 50, 66, 70].

Claim 8:

The field-useable guide of claim 6, wherein the class of living things comprises birds, and wherein the attributes include wingspan, body size and color of a designated part of the bird [paragraphs 50, 66, 70].

Claim 9:

The field-useable guide of claim 8, wherein the attributes include voice, with the data types including sounds produced by the items [paragraph 67].

Claim 10:

The field-useable guide of claim 8, wherein the attributes include tail shape [paragraphs 50, 66, 70].

Claim 11:

The field-useable guide of claim 8, wherein the attributes include wing type, as represented by images for values [paragraphs 50, 66, 70].

Claim 12:

The field-useable guide of claim 8, wherein the attributes include eye color [paragraphs 50, 66, 70].

Claim 13:

The field-useable guide of claim 8, wherein the attributes include patterns on various birds [paragraphs 50, 66, 70].

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Claim 14:

The field-useable guide of claim 1, wherein the search means includes means for enabling the user to select an order in which attributes are selected [paragraph 72].

Claim 15:

The field-useable guide of claim 1, wherein the means for displaying displays selectable attributes in a predetermined order, but wherein the search means includes means for enabling the user to select a desired order in which attributes are selected [paragraph 72].

Claim 16:

The field-useable guide of claim 1, wherein the means for displaying includes means for displaying visual icons representing groups of items among the collection of items [paragraph 59].

Claim 17:

The field-useable guide of claim 16, wherein the visual icons comprise silhouettes [paragraph 59].

Claim 18:

The field-useable guide of claim 1, wherein the search means and the means for displaying include a selectable show all feature with means for displaying to the user all items of the collection not eliminated, at a desired point in the user's search [paragraphs 61, 72, 73, 78].

Claim 19:

The field-useable guide of claim 1, wherein the search means and means for displaying include means for indicating the number of items remaining in the list of possibilities of the

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collection, after the user's selection of one or more attributes and values under those attributes [paragraphs 61, 72, 73,78].

Claim 20:

The field-useable guide of claim 1, wherein the user input comprises a touch screen for making selections [paragraph 79].

Claim 21:

The field-useable guide of claim 1, further including advanced search means associated with the microprocessor for enabling the user to perform a search wherein multiple attributes are selected in a single step, and a value selected under each attribute within such single step [paragraphs 61-67]

Regarding claims 22-43, examiner maintains such claims can be rejected under the prior art made of record in this Office action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Etienne LeRoux

12/9/2006

E P LeRoux

primary examiner